

REMARKS

I. Status of the Application.

Claims 1-21 of the Application were pending as of the date of the Office Action. In the Office Action, the Examiner:

- (a) Rejected claims 1-7 under 35 U.S.C. §101 as allegedly lacking patentable utility;
- (b) Rejected claims 1-5 and 7-21 under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,122,663 to Lin et al. ("Lin") in view of U.S. Patent No. 6,675,161 to Suchter ("Suchter"); and
- (c) Rejected claim 6 under 35 U.S.C. §103(a) as allegedly being obvious over Lin and Suchter in further view of U.S. Patent No. 6,725,228 to Clark et al. ("Clark").

Applicant respectfully submits that the remarks incorporated herein overcome the Examiner's rejections of the Application.

II. The Amendments Do Not Constitute New Matter.

Applicant respectfully submits that the amendments to claims 1-7 and 8 do not add new matter to the Application. The amendments to claim 8 are made to correct a typographical error and to clarify the claimed invention. Similarly, the amendments to claims 1-7 and 15 are made to clarify the claimed invention. Each of the amendments are supported in the Application as originally filed. For example, and among other places, the amendments are supported on pages 6-11 of the Application. For the above-listed reasons, Applicant respectfully submits that all the amendments are supported by the specification, as originally filed, and do not constitute new matter. Accordingly, Applicant respectfully requests entry of these amendments.

III. The Rejection Of Claims 1-7 Under 35 U.S.C. §101 As Lacking Patentable Utility Should Be Withdrawn.

Applicant respectfully submits that the rejection of claims 1-7 under 35 U.S.C. §101 is improper and should be withdrawn because the a *prima facie* showing that the claimed invention lacks utility has not been provided. "To properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing." MPEP §2107.2 III (citing *In re Gaubert*, 524 F.2d 1222 (CCPA 1975) ("Accordingly, the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability.")). An examiner bears the initial burden to develop a proper *prima facie* case by providing (i) an explanation that clearly sets forth the reasoning why the examiner concluded that the claimed invention does not set forth a specific and substantial or well-established utility; (ii) the factual findings and support for such findings that support the conclusion; and (iii) an evaluation of all relevant evidence of record and the utilities taught in the closest prior art. MPEP §2107.2 (III).

Applicant respectfully submits that the Examiner failed to develop a *prima facie* case because the Examiner did not provide an explanation that clearly sets forth the reasoning why the Examiner came to this conclusion nor set forth any supported factual findings to support the conclusion. The Examiner merely states that the computer readable medium is hardware and "cannot do itself the management, classification and protection of electronic document and/or records." (Office Action, p. 2). It is not clear how this statement supports a conclusion that the

claimed computer readable medium lacks utility and it appears from this statement that the Examiner has ignored the Applicant's definition of the term "computer readable medium" contained in the Application. As stated in the Application, the term "computer readable medium" means "any means (or electronic, magnetic, optical, or other physical device) that can store, communicate propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device." (Application, para. 0023). Regardless, in an effort to expedite the prosecution of this Application, Applicant has amended claims 1-7 to clarify that the computer readable medium is part of a "system for the management, classification and protection of electronic documents and/or records." Applicant respectfully submits that such amendment should address the Examiner's concern and that the rejection under 35 U.S.C. §101 should be withdrawn.

IV. The Rejection Of The Claims Under 35 U.S.C. §103(a) As Being Obvious Should Be Withdrawn.

Applicant respectfully submits that the claims are not obvious over any of the cited references. Three criteria must be met to establish a *prima facie* case of obviousness: (i) there must be some suggestion or motivation to combine the teachings of two or more prior art references; (ii) there must be a reasonable expectation of success; and (iii) "all of the claim limitations must be taught or suggested by the prior art." MPEP §§ 2143 and 2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)). "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing *In re Fine*, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

A. The Rejections Of Claims 1-5 And 7-21 As Being Obvious Over Lin In View Of Suchter Should Be Withdrawn.

Applicant respectfully submits that no suggestion or motivation exists to combine Suchter with Lin and that such a combination still does not teach or suggest all the limitations of amended independent claims 1, 8 and 15. Accordingly, Applicant respectfully submits that the rejection of claims 1-5 and 7-21 under 35 U.S.C. §103(a) should be withdrawn.

Lin discloses, teaches and suggests a system "for tracking program usage in a computer system" for billing purposes. (Col. 2, ll. 66-67). As part of this system, Lin utilizes a server computer 8 coupled to a client computer 1 that has a program monitor 4. (Col. 3, ll. 1-24). Program monitor 4 determines when an application is launched by client computer 1 and obtains and stores the time of the start of the application from server computer 8 in the local record file 5. (Col 4, ll. 60-67; Col 5, ll. 1-12). This application record is also stored in server computer 8 in remote database 10. (Col. 5, ll. 45-55). After the application is completed, program monitor 4 reports the end time of the application record to server computer 8, the remote database 10 is updated, and the application record is deleted from the local record file. (Col. 6, ll. 11-32). As noted by the Examiner, nothing in Lin discloses, teaches or suggests a system or method that classifies the record at the remote computer (or for that matter at all), as claimed in claims 1-21. (Office Action, pgs. 2-3).

Suchter discloses, teaches and suggests a method and apparatus for managing changes to a directory of electronic documents. (Col. 4, ll. 20-21). More specifically, Suchter discloses a way to organize electronic documents (i.e., hypertext links) in a search-and-retrieval system (i.e. a search engine system for the World Wide Web). (Col. 4, ll. 44-66). Suchter creates categories

in its database to store hypertext links to other online sites that relate to a specific topic (e.g., if the category is Animals & Outdoors, Suchter might have several sub-categories for a user to choose from and once the user chooses a specific sub-category it will be presented with several hypertext links to websites with an article on the topic). (Col. 5, ll. 60-67; Col. 6, ll. 1-67; Col. 7, ll. 1-49 and Tables I & II). While Suchter organizes hypertext files into categories, nothing in Suchter discloses a system or method that has logic, a step or a means that classifies a record at a remote computer while storing such a record at a separate central database.

Applicant respectfully submits that nothing in Lin provides any reason to classify or categorize the application record files that allow the Lin system to keep track of the client usage of a service through the disclosed server computer. Moreover, nothing in Suchter provides any reason to combine Suchter with Lin to better monitor such client usage or a reason to use Lin to better categorize electronic documents in a database. Lin and Suchter are aimed at solving two different unrelated problems. The Lin system is aimed at providing an adequate method and system to keep track of client usage while Suchter is aimed at providing a system that allows a user to surf the web easier and find hypertext links to articles related to a specific topic. Further, Suchter allows an owner or operator to manually remove, reorder or change attributes associated with an electronic document. (Col. 8, ll. 22-37). Lin specifically states that it does not want to allow a user to manipulate the data associated with an application record because this would cause inconsistencies with the usage fees. (Col. 5, 56-66). Applicant respectfully submits that there is nothing in either Lin or Suchter that would suggest or motivate one of ordinary skill in the art to combine Lin with Suchter because the systems and methods are used for unrelated

purposes and such a combination would actually provide the user the ability to manipulate its usage data so that the system in Lin would not be able to accurately keep track of the usage data for billing purposes.

Additionally, even if there were some motivation or suggestion that would lead one of ordinary skill in the art to combine Lin with Suchter, the combination of the references still does not yield the claimed invention of amended independent claims 1, 8 and 15. Specifically, the combination of Lin and Suchter does not disclose a system or method that either comprises logic, a step or a means "for classification of the record at a remote computer", as claimed in claims 1, 8 and 15, respectively. The Examiner specifically relies on the following language in Suchter to allege that this limitation of the claims is disclosed by the combination: "There can be many judgement for one document. For example, one electronic document could be classified in 10 categories and would have 10 corresponding IN judgement. Each judgement is defined by stored information." (Suchter, Col. 8, ll. 47-51). Applicant respectfully submits that nothing in this cited language and nothing in the rest of Suchter discloses, teaches or suggest a system or method that either comprises logic, a step or a means "for classification of the record at a remote computer", as claimed in claims 1, 8 and 15, respectively." Rather, Suchter discloses that the directory with the electronic documents is created and the electronic documents are categorized and stored on the same central server. (Fig. 1B, Col. 7, ll. 7-11 and 36-67; Col. 8, ll. 1-67; Col. 9, ll. 1-51). Accordingly, Applicant respectfully submits that a combination of Lin and Suchter does not disclose, teach or suggest all the limitations of the claims because neither Lin nor Suchter disclose, teach or suggest a system or method that either comprises logic, a step or a means "for

classification of the record at a remote computer", as claimed in claims 1, 8 and 15, respectively."

Thus, Applicant respectfully requests that the rejections of claims 1, 8 and 15 under 35 U.S.C. §103(a) should be withdrawn because (i) there is no suggestion nor motivation to combine Lin with Suchter and (ii) even if there was, the combination of Lin and Suchter does not teach nor disclose all the limitations of amended claims 1, 8 and 15. Moreover, Applicant respectfully submits that the rejections to claims 2-5, 7, 9-14, and 16-21 under 35 U.S.C. §103(a) should also be withdrawn because each of these claims depend from claims 1, 8 and 15, respectively.

B. The Rejection Of Claim 6 As Being Obvious Over Lin And Suchter In Further View Of Clark Should Be Withdrawn.

Applicant respectfully submits that the rejection of claims 6 under 35 U.S.C. §103(a) is now moot and should be withdrawn because this claim depends from amended claim 1, which as discussed above, is not obvious over Lin in view of Suchter. "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing *In re Fine*, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

VI. Applicants Petition for an Extension of Time.

Applicant hereby petitions for an extension of time of three (3) months, under 37 C.F.R. § 1.136(a), thereby extending the deadline for response, pursuant to 37 C.F.R. §§ 1.7(a) & 1.136(a), to Wednesday, December 13, 2006. Applicant authorizes payment for this extension in the amount of \$1,020.00 to be charged to the identified credit card. When doing so, please reference the above-listed docket number for this file.

CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that Applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this Application is therefore respectfully requested. In the event Applicant has inadvertently overlooked the need for payment of an additional fee, Applicant conditionally petitions therefore, and authorizes any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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